



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,836	06/08/2001	Osamu Yamada	19036/37156	3756

7590 12/28/2001

Thomas A Cawley Jr
Marshall O'Toole Gerstein Murray & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6402

EXAMINER

PAPPU, SITA S

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED: 12/28/2001

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,836

Applicant(s)

YAMADA ET AL.

Examiner

Sita S Pappu

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-18 and 20-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-6, 8-18 and 20-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Claims 1-6, 8-18 and 20-46 are pending in the instant application.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 8-18, 20-23, 28, 29, 31, 32, 38-40, 44, 45, drawn to a nucleic acid sequence for enhancing expression of a useful gene, comprising nucleotide sequence of SeqID NO:1, vector, host cell and method of producing a useful gene product.

Group II, claim(s) 24-27, 33, 34, 37, 41, 42, 43 drawn to a nucleic acid sequence for enhancing expression of a useful gene, comprising nucleotide sequence of SeqID NO:7, a probe for screening substances.

Group III, claim(s) 30, drawn to a method of expressing useful gene product.

Group IV, claim(s) 35, drawn to a therapeutic composition comprising the nucleic acid sequence of SeqID NO:1.

Group V, claim(s) 36, 46, drawn to a therapeutic composition comprising the nucleic acid sequence of Seq ID NO:7.

The inventions listed as Groups I-V, do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I comprises the nucleic acid of SeqID NO:1, a vector and host cell and method of producing the gene product, while group II comprises a nucleic acid of SeqID NO:7, and a probe comprising SeqID NO:7. Thus the special technical feature of group I, which is the nucleic acid of SeqID NO:1 is not present in group II and vice versa.

Group III, claim 30 is directed to a method of expressing useful gene product and reads on *in vivo*, *ex vivo* and/or *in vitro* methods. These methods are materially different and thus, there is no one-to-one correspondence between the special technical features of Groups I (which is the nucleic acid of SeqID NO:1), and the method of expressing the gene product, and, thus, Group III is distinct from Group-I. Further, claim 30 is directed to the method of expressing the nucleic acid of Seq ID NO:1 which is different from the special technical feature of Group-II, which is the nucleic acid of Seq ID NO:7. Thus, Groups II and III are distinct.

Groups IV and V, involve therapeutic compositions of SeqID NO:1 and SeqID NO:7 respectively, and lack the same technical feature uniting the groups. The special technical feature of Group IV is the nucleic acid of Seq ID NO:1 and the special technical feature of Group V is the nucleic acid of Seq ID NO:7. However, Group IV is different from Group I, although both have the same technical feature, which is the nucleic acid of Seq ID NO:1, since the nucleic acid of Group IV is a therapeutic composition for treating diseases and, as explained herein below, lacks one-to-one correspondence with the methods of using the nucleic acid.

Group V is different from Group II, although both have the same technical feature, which is the nucleic acid of Seq ID NO:7, since the nucleic acid of Group V is a therapeutic composition for treating diseases and as explained herein below, lacks one-to-one correspondence with the methods of using the nucleic acid.

The nucleic acids of Group I comprising SeqID NO:1 and the nucleic acids of Group II comprising SeqID NO:7 lack one-to-one correspondence with the methods of using them. These two nucleic acids are claimed in their variant forms represented by deletions, substitutions and insertions and, thus, lack one-to-one correspondence with the methods of using them.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

Art Unit: 1632

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sita S Pappu whose telephone number is (703) 305-5039. The examiner can normally be reached on Mon-Fri (9:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Crouch can be reached on (703) 308-1126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746 7442 for regular communications and (703) 746 7442 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-2758.

S. Pappu
December 21, 2001

Anne-Marie Baker
ANNE-MARIE BAKER
PATENT EXAMINER